

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated September 09, 2004, in which:

- claims 9, 19, and 25 are rejected under 35 U.S.C. § 112, 2nd paragraph as indefinite;
- and claims 1-37 are rejected under 35 U.S.C. § 102(e) on Swamy (US Patent No. 6,686,759 B1).

Reconsideration of the above referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

A Petition for Extension of Time in order to extend the period for response 1 month(s), including the appropriate fee, is filed herewith.

Claims 1-37 are now pending the above referenced patent application. Claims 9, 19, and 25 have been amended to address minor matters of form, and, therefore, do not result in prosecution history estoppel and do not alter the scope of the claims as originally filed. No new matter has been entered. No claims have been cancelled, or added.

1. 35 U.S.C. § 112, 2nd paragraph***1.1. Claims 9, 19, and 25***

The PTO has rejected claims 9, 19, and 25 under 35 U.S.C. § 112, 2nd paragraph.

Although Applicants respectfully disagree that these claims are indefinite, however rather than belabour the point, Applicants have amended the claims to address the PTO's concerns. No new matter has been entered. It is respectfully asserted that these amendments are merely directed to matters of form, and, therefore, do not result in prosecution history estoppel and either broaden or do not alter the scope of the claims. It is respectfully requested that the foregoing claim rejections be withdrawn.

2. 35 U.S.C. § 102

2.1. *Swamy: Claims 1-37*

The PTO has rejected claims 1-37 under 35 U.S.C. § 102(e) as being anticipated by Swamy. This rejection by the PTO of these claims is respectfully traversed.

It is well-established that in order to establish a *prima facie* case of anticipation under § 102 of the patent statute, the PTO must provide a single prior art document that alone has every element and every limitation of the claim being rejected. Therefore, if even a single element or limitation is not met by the asserted document, then the PTO has not succeeded in establishing a *prima facie* case.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants begin with claim 1. Claim 1 recites:

1 1: (Previously Presented) An apparatus which comprises:
2 a multi-core processor and
3 at least one test control mechanism, including at least one test access port
4 controller (TAPC) and a plurality of distributed data and control registers;
5 said multi-core processor and said test control mechanism having a
6 configuration so as to allow testing of said multi-core processor.

It is respectfully asserted that, as just one example of how the text cited by the PTO fails to meet the language of the rejected claims, Swamy does not show, teach, use, or describe a plurality of distributed data and control registers. While Swamy does show a plurality of TAPs, no TAP includes a plurality of distributed data and control registers. See, Swamy Fig

2, element 60. Also, see Swamy, Fig. 1 in which a single data register (boundary-scan 24) is shown, and no control registers are illustrated. It is noted that one skilled in the art of TAP design will understand that a boundary-scan chain is considered, and referred to in the IEEE 1149 specification as a single data register. Applicants respectfully contend that Swamy fails to satisfy a *prima facie* case of anticipation as directed by 35 U.S.C. § 102.

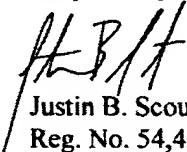
Furthermore, Applicants note that the filing date of Swamy is November 28, 2000, which is approximately 1 month before Applicants filing date, December 22, 2000. It is respectfully asserted that even if Swamy anticipated every one of Applicants' claims, which Applicants do not agree with, it is highly probable that a proper 37 C.F.R. § 1.131 Declaration may be filed to render Swamy invalid as § 102(e) art.

Claims 2-37 either depend from claim 1, or include a substantially similar and patentably distinct limitation as claim 1. It is, therefore, respectfully requested that the rejection of these claims also be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,



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Sun Dec 19, 2004

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